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FEB 08 2005

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Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**Mail Stop: Amendment**

Re: U.S. Utility Patent Application  
Appl. No. 10/005,876; Filed: December 7, 2001  
For: **Methods and Compositions for Synthesis of Nucleic Acid Molecules  
Using Multiple Recognition Sites**  
Inventors: CHESNUT *et al.*  
Our Ref: 0942.5340002/RWE/BJD/JKM

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Ninth Supplemental Information Disclosure Statement;
2. List of cited references on Form PTO-1449 (2 pages);
3. Copies of references **AN14, AS136, AT136 and AS137** listed on Form PTO-1449 (4 documents); and
4. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents  
February 8, 2005  
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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BJD/JKM:bac  
Enclosures

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FEB 08 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Chesnut *et al.*

Appl. No.: 10/005,876

Filed: December 7, 2001

For: **Methods and Compositions for  
Synthesis of Nucleic Acid  
Molecules using Multiple  
Recognition Sites**

Confirmation No.: 7958

Art Unit: 1636

Examiner: Ketter, J.S.

Atty. Docket: 0942.5340002/RWE/BJD/JKM

**Ninth Supplemental Information Disclosure Statement**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450  
Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

The numbering on this Ninth Supplemental Information Disclosure Statement is a continuation of the numbering in Applicants' Eighth Supplemental Information Disclosure Statement filed January 21, 2005, in connection with the above-captioned application.

Copies of documents **AF12-AK12** and **AA13-AI13** are not provided in accordance with the Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, effective October 21, 2004, which states "section 1.98(a)(2)(i) is amended to eliminate the requirement in paragraph (a)(2)(i) for a copy of each U.S. patent or U.S. patent application publication listed in an IDS in a patent application regardless of the filing date of the application."

A copy of document **AR137** is not provided in accordance with the U.S. Patent and Trademark Office OG notice of October 19, 2004, which states: "the requirement in 37 C.F.R. § 1.98(a)(2)(iii) for a legible copy of the specification, including the claims, and drawings of each cited pending U.S. patent application (or portion of the application which caused it to be listed) is *sua sponte* waived where the cited pending application is stored in the USPTO's IFW system." A copy of each other document is provided.

The Examiner's attention is directed to the following co-pending U.S. Patent Application, which is directed to related technical subject matter:

U.S. Patent Application No. 10/970,635, Hanson, filed October 22, 2004 and cited herewith as document **AR137**.

The identification of this U.S. Patent Application is not to be construed as a waiver of secrecy as to this application now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited application and the art cited therein during examination.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached Form PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior

art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

This Information Disclosure Statement is being filed before the mailing of a first Office Action after the filing of a Request for Continued Examination under 37 C.F.R. § 1.114. No statement or fee is required.

It is respectfully requested that the Examiner initial and return a copy of the enclosed Form PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: Feb. 8, 2005  
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360377\_1.DOC

FORM PTO-1449

**NINTH SUPPLEMENTAL**  
**INFORMATION DISCLOSURE STATEMENT**

ATTY. DOCKET NO.  
0942.5340002/RWE/BJD/JKMAPPLICATION NO.  
10/005,876APPLICANT(S)  
Chesnut *et al.*FILING DATE  
December 7, 2001ART UNIT  
1636FEB 08 2005  
P-1000**U.S. PATENT DOCUMENTS**

| EXAMINER INITIAL |      | DOCUMENT NUMBER | DATE       | NAME                   | CLASS | SUB-CLASS | FILING DATE |
|------------------|------|-----------------|------------|------------------------|-------|-----------|-------------|
|                  | AA   |                 |            |                        |       |           |             |
|                  | AB   |                 |            |                        |       |           |             |
|                  | AC   |                 |            |                        |       |           |             |
|                  | AD   |                 |            |                        |       |           |             |
|                  | AE   |                 |            |                        |       |           |             |
|                  | AF12 | 6,040,138       | 03/21/2000 | Lockhart <i>et al.</i> |       |           | 09/15/1995  |
|                  | AG12 | 6,303,301       | 10/16/2001 | Mack                   |       |           | 05/29/1998  |
|                  | AH12 | 6,309,822       | 10/30/2001 | Fodor <i>et al.</i>    |       |           | 12/23/1996  |
|                  | AI12 | 6,333,155       | 12/25/2001 | Lockhart <i>et al.</i> |       |           | 12/18/1998  |
|                  | AJ12 | 2002/0162126    | 10/31/2002 | Beach <i>et al.</i>    |       |           | 05/24/2001  |
|                  | AK12 | 6,544,790       | 04/08/2003 | Sabatini               |       |           | 09/18/2000  |

**FOREIGN PATENT DOCUMENTS**

| EXAMINER INITIAL |      | DOCUMENT NUMBER | DATE       | COUNTRY | CLASS | SUB-CLASS | TRANSLATION |
|------------------|------|-----------------|------------|---------|-------|-----------|-------------|
|                  | AL   |                 |            |         |       |           | Yes<br>No   |
|                  | AM   |                 |            |         |       |           | Yes<br>No   |
|                  | AN14 | WO 01/68836     | 09/20/2001 | WIPO    |       |           | Yes<br>No   |
|                  | AO   |                 |            |         |       |           | Yes<br>No   |
|                  | AP   |                 |            |         |       |           | Yes<br>No   |

**OTHER (Including Author, Title, Date, Pertinent Pages, etc.)**

|  |    |     |   |
|--|----|-----|---|
|  | AR |     |   |
|  | AS | 136 | Baum, J.A., "Tn5401, a New Class II Transposable Element From <i>Bacillus thuringiensis</i> ," <i>J. Bacteriol.</i> 176:2835-2845, American Society for Microbiology (1994) |
|  | AT | 136 | Office Action for U.S. Patent Application No. 10/796,868, mailed on January 25, 2005  |

EXAMINER

DATE CONSIDERED

**EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

| FORM PTO-1449<br><b>NINTH SUPPLEMENTAL</b><br><b>INFORMATION DISCLOSURE STATEMENT</b>   |      |                 | ATTY. DOCKET NO.<br>0942.5340002/RWE/BJD/JKM  |                       | APPLICATION NO.<br>10/005,876 |           |             |
|---|------|-----------------|---|-----------------------|-------------------------------|-----------|-------------|
|   |      |                 | APPLICANT(S)<br>Chesnut <i>et al.</i>   |                       |                               |           |             |
|   |      |                 | FILING DATE<br>December 7, 2001   |                       | ART UNIT<br>1636              |           |             |
| <b>U.S. PATENT DOCUMENTS</b>  |      |                 |   |                       |                               |           |             |
| EXAMINER INITIAL  |      | DOCUMENT NUMBER | DATE  | NAME                  | CLASS                         | SUB-CLASS | FILING DATE |
|   | AA13 | 2003/0135888    | 07/17/2003  | Zhu <i>et al.</i>     |                               |           | 09/26/2002  |
|   | AB13 | 2003/0175772    | 09/18/2003  | Wang                  |                               |           | 12/26/2002  |
|   | AC13 | 2004/0040053    | 02/26/2004  | Nomura <i>et al.</i>  |                               |           | 11/22/2002  |
|   | AD13 | 2004/0219516    | 11/04/2004  | Bennett <i>et al.</i> |                               |           | 07/18/2003  |
|   | AE13 | 2004/0219673    | 11/04/2004  | Hartley <i>et al.</i> |                               |           | 03/10/2004  |
|   | AF13 | 2004/0229229    | 11/18/2004  | Cheo <i>et al.</i>    |                               |           | 08/14/2003  |
|   | AG13 | 2004/0253631    | 12/16/2004  | Hartley <i>et al.</i> |                               |           | 07/19/2004  |
|   | AH13 | 2004/0265863    | 12/30/2004  | Chesnut <i>et al.</i> |                               |           | 03/04/2004  |
|   | AI13 | 2005/0009091    | 01/13/2005  | Hartley <i>et al.</i> |                               |           | 08/19/2004  |
|   | AJ   |                 |   |                       |                               |           |             |
|   | AK   |                 |   |                       |                               |           |             |
| <b>FOREIGN PATENT DOCUMENTS</b>   |      |                 |   |                       |                               |           |             |
| EXAMINER INITIAL  |      | DOCUMENT NUMBER | DATE  | COUNTRY               | CLASS                         | SUB-CLASS | TRANSLATION |
|   | AL   |                 |   |                       |                               |           | Yes<br>No   |
|   | AM   |                 |   |                       |                               |           | Yes<br>No   |
|   | AN   |                 |   |                       |                               |           | Yes<br>No   |
|   | AO   |                 |   |                       |                               |           | Yes<br>No   |
|   | AP   |                 |   |                       |                               |           | Yes<br>No   |
| <b>OTHER (Including Author, Title, Date, Pertinent Pages, etc.)</b>   |      |                 |   |                       |                               |           |             |
|   | AR   | <u>137</u>      | U.S. Patent Application No. 10/970,635, Hanson, filed October 22, 2004<br>(NOT PUBLISHED)   |                       |                               |           |             |
|   | AS   | <u>137</u>      | Short, J.M. <i>et al.</i> , " $\lambda$ ZAP: a bacteriophage $\lambda$ expression vector with <i>in vivo</i> excision properties," <i>Nucleic Acids Research</i> 16:7583-7600, IRL Press Limited (1988) |                       |                               |           |             |
|   | AT   |                 |   |                       |                               |           |             |
| EXAMINER  |      |                 |   |                       | DATE CONSIDERED               |           |             |
| <b>EXAMINER:</b> Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant. |      |                 |   |                       |                               |           |             |